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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO.          | CONFIRMATION NO.       |
|--|-------------|-----------------------|------------------------------|------------------------|
| 10/675,865   | 09/30/2003  | Toshiyuki Miyabayashi | U 014833-7                   | 1874                   |
| 7590<br>William R. Evans<br>Ladas & Parry<br>26 West 61 Street<br>New York, NY 10023 |             | 02/20/2007            | EXAMINER<br>SHOSHO, CALLIE E |                        |
|  |             |                       | ART UNIT<br>1714             | PAPER NUMBER           |
|  |             |                       | MAIL DATE<br>02/20/2007      | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/675,865

Applicant(s)

MIYABAYASHI, TOSHIYUKI

Examiner

Callie E. Shosho

Art Unit

1714

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 25 January 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-31.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

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Primary Examiner  
Art Unit: 1714

**Attachment to Advisory Action**

1. Applicants' amendment filed 1/25/07 has been fully considered, however, the amendment has not been entered given that the amendment raises new issues that would require further consideration.

Specifically, the amendment raises new issues that would require further consideration under 35 USC 112, second paragraph with respect to claims 18-21.

The scope of each of claims 18-21 is confusing given that the claims, which each ultimately depend on claim 1, recite the concentration after purification treatment of "unreacted anionically polymerizable surface active agent and/or hydrophilic monomer having an anionic group" while claim 1 has been amended to recite that the polymer "optionally" has repeating structural unit of hydrophilic monomer having an anionic group. Thus, while claim 1 has been amended to recite that the polymer requires a repeating structural unit derived from an anionically polymerizable surface active agent and optionally a repeating structural unit of hydrophilic monomer having an anionic group, claims 18-21 each still recites unreacted anionically polymerizable surface active agent and/or hydrophilic monomer having an anionic group and thus, it is not clear from claims 18-21 what repeating structural units are required in the polymer. When claim 1 encompasses, for instance, a polymer comprising a repeating structural unit of cationically polymerizable surface active agent and a repeating structural unit of anionically polymerizable surface active agent, i.e. hydrophilic monomer having an anionic group is not present, the scope of each of claims 18-21 is confusing given that it is not clear how the aqueous dispersion would contain unreacted hydrophilic monomer having an anionic group given that the polymer is not obtained from any such hydrophilic monomer. When claim 1

encompasses a polymer comprising a repeating structural unit of cationically polymerizable surface active agent, a repeating structural unit of anionically polymerizable surface active agent, and a repeating structural unit of a hydrophilic monomer having an anionic group, the scope of each of claims 18-21 is confusing given that it is not clear if only one of the unreacted anionically polymerizable surface active agent or hydrophilic monomer having an anionic group must be present in concentration of 50,000 ppm or less or if a combination of the unreacted anionically polymerizable surface active agent and hydrophilic monomer having an anionic group must be present in concentration of 50,000 ppm or less.

Further, even *if* the amendment were entered, claims 2, 4, and 11-15 would not be allowable over the prior art. Claims 2, 4, and 11-12 would remain rejected by Hayashi et al. (U.S. 5,415,964) in view of Mishina et al. (U.S. 6,511,534), claims 2, 4, and 11-15 would remain rejected by WO 2001/96483 in view of Mishina et al., and claims 2, 4, 11, and 15 would remain rejected by Vincent et al. (U.S. 2004/0157956) in view of Mishina et al.

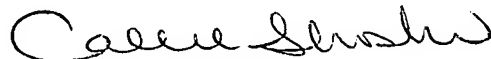
Specifically, while claim 1 has been amended to recite that the microencapsulated pigment contains polymer comprising a repeating structural unit derived from a cationically polymerizable surface active agent and a repeating structural unit derived from an anionically polymerizable surface active agent and optionally a repeating structural unit of hydrophilic monomer having an anionic group, no such amendment has been made to any of claims 2, 11, or 12.

Thus, claims 2, 4, and 11-15 still require pigment coated with polymer comprising a repeating structural unit derived from cationically polymerizable surface active agent and a

Art Unit: 1714

repeating structural unit derived from an anionically polymerizable surface active agent **and/or** a hydrophilic monomer having an anionic group, which encompasses pigment coated with polymer comprising (i) a repeating structural unit derived from a cationically polymerizable surface active agent and a repeating structural unit derived from an anionically polymerizable surface active agent or (ii) a repeating structural unit derived from a cationically polymerizable surface active agent, a repeating structural unit derived from an anionically polymerizable surface active agent, and hydrophilic monomer having anionic group or (iii) a repeating structural unit derived from a cationically polymerizable surface active agent and hydrophilic monomer having anionic group. With respect to present claims 2, 4, and 11-15, the examiner's position remains that the prior art of record set forth in paragraphs 5-10 of the office action mailed 2/13/06 meets the requirements of embodiment (iii).

It is noted, however, that *if* the amendment were entered, the amendment would overcome the rejections of record against present claims 1, 3, 5-10, and 16-31.



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CS  
2/14/07